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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,032	06/20/2003	David J. Hammond	222363	5177
22428	7590	01/11/2006	EXAMINER	
FOLEY AND LARDNER LLP			STEELE, AMBER D	
SUITE 500			ART UNIT	
3000 K STREET NW			PAPER NUMBER	
WASHINGTON, DC 20007			1639	

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/601,032	Applicant(s) HAMMOND ET AL.	
	Examiner Amber D. Steele	Art Unit 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date ____.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
 Paper No(s)/Mail Date. ____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: ____.</p> |
|---|---|

DETAILED ACTION

Status of the Claims

1. Claims 1-27 are currently pending.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-24 are drawn to a method of screening a mixture for active entities, classified in class 435, subclass 4.
 - II. Claim 26 is drawn to a method of screening a pool of dissociated entities, classified in class 530, subclass 412.
 - III. Claims 25 and 27, drawn to a method of screening a pool of entities in a concentration gradient, classified in class 536, subclass 127.
3. The inventions are independent and/or distinct, each from the other because of the following reasons:

Groups I-III represent separate and patentably distinct inventions. Groups I-III are drawn to different methods that are directed to different purposes, recite different method steps, and/or use different materials. For example, Group II requires a step of "removing from the pools the ligand-support complexes" which is not required in Groups I or III and Group III requires a step of "adding a semi-solid or viscous material to each pool" which is not required by Group I or II. Therefore, Groups I-III have different issues regarding patentability and enablement. Additionally, Groups I-III represent patentably distinct subject matter which merits separate and burdensome searches. Art anticipating or

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rendering obvious Group I would not necessarily anticipate or render obvious Group II or III and *vice versa*, because they are drawn to different inventions that have different distinguishing features. Furthermore, Groups I-III have a separate status in the art as shown by the different classification (please refer to section 2).

4. Because these inventions are distinct for the reasons given above and:
 - a. have acquired a separate status in the art as shown by their different classification (please refer to paragraph 1), and/or
 - b. divergent subject matter which would require different bibliographic and/or classification searches; and/or
 - c. because the inventions have acquired a separate status in the art because of the recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Species Election

5. This application contains claims directed to the following patentably distinct species of the claimed inventions for Groups I-III. Election is required as follows.
6. If applicant elects the invention of **Group I**, the applicant is required to elect a single, specific species from **each** of the following species A-E.
 - A. species of ligand (please refer to claims 2-3)Applicant must elect, for the purposes of search, a **single, specific species** of ligand.

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B. species of support (please refer to claim 4)

Applicant must elect, for the purposes of search, a **single, specific species** of support.

C. species of mixture/composition (please refer to claims 5-10 and 22)

Applicant must elect, for the purposes of search, a **single, specific species** of mixture/composition.

D. species of entity (please refer to claim 11)

Applicant must elect, for the purposes of search, a **single, specific species** of entity.

E. species of activity (please refer to claims 12-17)

Applicant must elect, for the purposes of search, a **single, specific species** of activity. In addition, if applicants elect an activity that has an effect of a cell, tissue, or organism, applicants must also indicate if the cell, tissue, or organism is diseased. Furthermore, if applicants elect a diseased cell, tissue, or organism, applicants must **also** elect a **single, specific species** of disease (please refer to claims 16-17).

It would necessarily be unduly burdensome to search each of the above species of the presently claimed methods since it would entail different and separately burdensome manual/computer bibliographic searches in the patent and nonpatent literature databases and/or additionally a reference against one species may not necessarily anticipate or render obvious the other and/or the different species may elicit different issues under 35 U.S.C. 112.

7. If applicant elects the invention of **Group II**, the applicant is required to elect a single, specific species from **each** of the following species A-E.

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A. species of ligand

Applicant must elect, for the purposes of search, a **single, specific species** of ligand.

B. species of support

Applicant must elect, for the purposes of search, a **single, specific species** of support.

C. species of mixture

Applicant must elect, for the purposes of search, a **single, specific species** of mixture.

D. species of entity

Applicant must elect, for the purposes of search, a **single, specific species** of entity.

E. species of activity

Applicant must elect, for the purposes of search, a **single, specific species** of activity.

It would necessarily be unduly burdensome to search each of the above species of the presently claimed methods since it would entail different and separately burdensome manual/computer bibliographic searches in the patent and nonpatent literature databases and/or additionally a reference against one species may not necessarily anticipate or render obvious the other and/or the different species may elicit different issues under 35 U.S.C. 112.

8. If applicant elects the invention of **Group III**, the applicant is required to elect a single, specific species from **each** of the following species A-F.

A. species of ligand

Applicant must elect, for the purposes of search, a **single, specific species** of ligand.

B. species of support

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Applicant must elect, for the purposes of search, a **single, specific species** of support.

C. species of mixture

Applicant must elect, for the purposes of search, a **single, specific species** of mixture.

D. species of entity

Applicant must elect, for the purposes of search, a **single, specific species** of entity.

E. species of activity

Applicant must elect, for the purposes of search, a **single, specific species** of activity.

F. species of semi-solid/viscous material

Applicant must elect, for the purposes of search, a **single, specific species** of semi-solid/viscous material.

It would necessarily be unduly burdensome to search each of the above species of the presently claimed methods since it would entail different and separately burdensome manual/computer bibliographic searches in the patent and nonpatent literature databases and/or additionally a reference against one species may not necessarily anticipate or render obvious the other and/or the different species may elicit different issues under 35 U.S.C. 112.

9. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, **and a listing of all claims readable thereon, including any claims subsequently added.** An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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10. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

11. Should applicant traverse on the grounds that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

12. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement may be traversed (37 CFR 1.143). Because the above restriction/election requirement is complex, a telephone call to applicant to request an oral election was not made. See MPEP § 812.01.

13. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Future Correspondences

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amber D. Steele whose telephone number is 571-272-5538. The examiner can normally be reached Monday through Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached at 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ADS

December 28, 2005



ANDREW WANG
SUPERVISORY PATENT EXAMINER
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